IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

THE GIDEONS INTERNATIONAL, INC.	:	CIVIL ACTION
v.	:	
GIDEON 300 MINISTRIES, INC.	:	NO. 97-7251

MEMORANDUM AND ORDER

HUTTON, J. May 3, 1999

Presently before the Court are the Plaintiff The Gideons International, Inc.'s Motion for Summary Judgment (Docket No. 17), the Memorandum in Support of the Plaintiff's Motion (Docket No. 20) the Defendant Gideon 300 Ministries, Inc.'s Response (Docket No. 23), and the Plaintiff's Reply Brief (Docket No. 26), the Defendant's Motion for Summary Judgment (Docket No. 18), and the Plaintiff's response thereto (Docket No. 24). For the reasons stated below, the Defendant's Motion for Summary Judgment is **DENIED** and the Plaintiff's Motion for Summary Judgment is **DENIED**.

I. BACKGROUND

This is a trademark infringement case. On November 26, 1997, The Gideons International, Inc. ("The Gideons" or "Plaintiff") filed a complaint against Gideon 300 Ministries, Inc. ("Gideon 300" or "Defendant") alleging trademark infringement pursuant to 15 U.S.C. § 1114(1), 1125(a) and (c) in addition to

state law claims. Both parties now move for summary judgment pursuant to Federal Rule of Civil Procedure 56(c).

The Gideons, founded in 1899, serves as an extended missionary arm of the church and is the oldest Christian business and professional men's association in the United States of America. The Gideons deal in the distribution and placement of Bibles throughout the United States and around the world. The Gideons first began to use the names and marks GIDEON and GIDEONS in interstate commerce in connection with its services described above in 1903 on magazines and other printed literature, and has continued that use to the present time.

Gideon 300 was founded in 1996 for the purpose of distributing food to the homeless. In connection with its activities, Gideon 300 Ministries distributes on an annual basis approximately 15,000 pieces of literature where the names GIDEON 300 and/or GIDEON 300 MINISTRIES appear. Gideon 300 alleges that the name “Gideon” can be traced back to the Old Testament book of Judges, which is approximately 3,000 years old. It contends that since that time, hundreds, if not thousands of organizations have lawfully used the word Gideon in connection with their business or activity. Because discovery has been completed in this case, the parties’ motions for summary judgment are ripe for review.

II. SUMMARY JUDGMENT STANDARD

Summary judgment is appropriate "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of showing the basis for its motion. See Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986). Once the movant adequately supports its motion pursuant to Rule 56(c), the burden shifts to the nonmoving party to go beyond the mere pleadings and present evidence through affidavits, depositions, or admissions on file to show that there is a genuine issue for trial. See id. at 324. A genuine issue is one in which the evidence is such that a reasonable jury could return a verdict for the nonmoving party. See Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986).

When deciding a motion for summary judgment, a court must draw all reasonable inferences in the light most favorable to the nonmovant. See Big Apple BMW, Inc. v. BMW of N. Am., Inc., 974 F.2d 1358, 1363 (3d Cir. 1992). Moreover, a court may not consider the credibility or weight of the evidence in deciding a motion for summary judgment, even if the quantity of the moving party's evidence far outweighs that of its opponent. See id. Nonetheless, a party opposing summary judgment must do more than rest upon mere

allegations, general denials, or vague statements. See Trap Rock Indus., Inc. v. Local 825, 982 F.2d 884, 890 (3d Cir. 1992).

III. DISCUSSION

A. The Law of Trademark

To succeed in a claim for trademark infringement under section 32 of the Lanham Act, the owner of a valid and legally protectable mark, such as The Gideon, must show that the defendant has used a confusingly similar mark. Section 32(1) provides in pertinent part:

> Any person who shall, without the consent of the registrant--
> (a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; ... shall be liable in a civil action by the registrant....

15 U.S.C. § 1114(1) (emphasis added).

The same standard is embodied in section 43(a) of the Lanham Act, which governs unfair competition claims. That section provides, in pertinent part:

> Any person who, on or in connection with any goods or services, ... uses in commerce any word, term, name, symbol, or device ... or any false designation of origin ... which--
> (A) is likely to cause confusion, or to cause mistake, or to deceive as to ... the origin, sponsorship, or approval of [his or her] goods, services, or commercial activities by another person ... shall be liable in a

> civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a)(1) (emphasis added).

To prove trademark infringement, under both federal and Pennsylvania law, a plaintiff must show: (1) that the mark is valid and legally protectable; (2) that the mark is owned by the plaintiff; and (3) that the defendant's use of the mark to identify goods or services is likely to create confusion concerning the origin of the goods or services. Fisons Horticulture, Inc. v. Viogoro Industries, Inc., 30 F.3d 466, 472 (3rd Cir.1994) (citations omitted); See also Guardian Life Ins. v. American Guardian Life Assur., 943 F.Supp. 509, 517 (E.D.Pa.1996) (citations omitted) ("The elements of a cause of action for unfair competition under Pennsylvania common law are identical to those under [federal law], with the exception that the goods need not have traveled in interstate commerce.").

B. Plaintiff's Claim

It is not refuted that the Plaintiff satisfies the first two elements. First, the Plaintiff's marks (GIDEON and GIDEONS) are valid and legally protectable. Second, The Gideons owns the marks. Thus, the Court need not consider those issues now. For the reasons stated below, however, the Court finds that a genuine issue of material fact exists with regard to the third element. This Court cannot find as a matter of law that Gideon 300's use of

the GIDEON mark is likely to create confusion concerning the origin of the goods or services. Accordingly, this Court is unable to resolve this case on a motion for summary judgment.

1. Confusion

The Third Circuit has explained that the third element, likelihood of confusion, exists "when the consumers viewing the mark would probably assume that the product or service it represents is associated with the source of a different product or service identified by a similar mark." Fisons, 30 F.3d at 472 (citing Dranoff-Perlstein Assoc. v. Sklar, 967 F.2d 852, 862 (3d Cir.1992) (internal quotations omitted)). A plaintiff's showing of proof for the third element depends on whether the products or services offered by the trademark owner and the alleged infringer are in competition. If plaintiff and defendant deal in competing products or services, "the court need rarely look beyond the mark itself." Id. at 472(citing Lapp, 721 F.2d at 462 (further citations omitted)). For competing products or services, the court focuses on the marks to determine whether they are "confusingly similar." Id. at 473 (citing Country Floors, Inc. v. Gepner, 930 F.2d 1056, 1063 (3d Cir.1991)). However, where the products or services are not competing, the similarity of the marks is only one of the factors the court must examine to determine likelihood of confusion.

a. Competition

In determining whether the Plaintiff's and the Defendant's products and services are in competition, courts examine whether the products and services can be substituted or interchanged for one another. See Safeguard Bus. Systems Inc. v. New England Bus. Systems, Inc., 696 F.Supp. 1041, 1044 (E.D.Pa.1988). In this case, The Gideons' contend that it distributes and places Bibles in such public institutions as hotels and hospitals. Conversely, Gideon 300 claims that it provides meals to the homeless.

Nonetheless, both The Gideons and Gideon 300 seek to introduce the public to the Christian faith through various methods. Although Gideon 300 does not distribute Bibles, it does have a "Read the Bible in a Year" program, and conducts Christian ministries. In fact, The Gideons is involved with churches and institutions that Gideon 300 is involved. Thus, the Court finds that a genuine issue of fact exists as to whether the Plaintiff and the Defendant deal in competing products or services.

b. The Third Circuit's ten Lapp factors

Where plaintiff and defendant deal in non-competing products or services, as is the case here, the Third Circuit has held that "the court must look beyond the trademark to the nature of the products or services, and to the context in which they are marketed and sold. The closer the relationship between the

products or services, and the more similar their sales contexts, the greater the likelihood of confusion." Lapp, 721 F.2d at 462 (citations omitted).

Likelihood of confusion is also the test for actions brought under section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A), for unfair competition to prevent false representations as to the source or origin of products or services by a mark confusingly similar to one already in use. Fisons, 30 F.3d at 473; see, e.g., Sun-Fun Products, Inc. v. Suntan Research & Development Inc., 656 F.2d 186, 192 (5th Cir.1981) (finding factors relevant to unfair competition claim under 15 U.S.C. § 1125 "essentially the same" as those factors relevant to trademark infringement claim under 15 U.S.C. § 1114). As the United States Supreme Court has commented in an historical context, "The law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting consumers from confusion as to source." Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 157, 109 S.Ct. 971, 103 L.Ed.2d 118 (1989).

The Third Circuit applies a ten factor test to determine likelihood of confusion in cases of trademark infringement and unfair competition involving non-competing products or services. Fisons, 30 F.3d at 473 (citing Dranoff-Perlstein, 967 F.2d at 862-63; Ford Motor Co., 930 F.2d at 293; Lapp, 721 F.2d at 463; Scott Paper, 589 F.2d at 1229). These ten factors, known as the

Lapp factors, or the Scott Paper factors, include:

(1) The degree of similarity between the owner's trademark and the alleged infringing mark;

(2) The strength of the owner's mark;

(3) The price of the products or services and other factors indicative of the care and attention expected of consumers when making a purchase;

(4) The length of time defendant has used the mark without evidence of actual confusion arising;

(5) Defendant's intent in adopting the mark;

(6) Evidence of actual confusion;

(7) Whether the products or services, though not competing, are marketed through the same channels of trade and advertised in the same media;

(8) The extent to which targets of the parties' sales efforts are the same;

(9) The relationship of the products or services in the minds of consumers because of the similarity of function; and

(10) Other facts suggesting that the consuming public might expect the prior owner to manufacture a product or provide a service in the defendant's market, or that he is likely to expand into that market.

See Fisons, 30 F.3d at 473; Lapp, 721 F.2d at 463; Scott Paper, 589 F.2d at 1229.

The Third Circuit has made it clear that the plaintiff does not have to prove actual confusion if the mark is registered and incontestable; "likelihood of confusion is all that need be shown." Fisons, 30 F.3d at 472 (citing Ford Motor Co., 930 F.2d at 292 (internal citations omitted)). Where plaintiff's and defendant's products and services are not in direct competition, the court applies the ten Lapp factors. Id. at 475. In applying the Lapp factors, the court must weigh each factor separately, however, not all ten factors must be weighed equally. Id. at 476. The Third Circuit has explained that "[t]he weight given to each factor in the overall picture, as well as its weighing for plaintiff or defendant, must be done on an individual fact-specific basis." Id. at 476 n. 11. Moreover, the court must treat each trademark infringement case as fact-specific; the court must, therefore, decide a case based on its unique own circumstances. See Scott Paper, 589 F.2d at 1231.

In the present matter, the Court finds that it has insufficient evidence before it to find as a matter of law that the Lapp factors decisively favor one party or the other.

An appropriate Order follows.

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O R D E R

AND NOW, this 3rd day of May, 1999, upon consideration of the Plaintiff The Gideons International, Inc.'s Motion for Summary Judgment (Docket No. 17), the Memorandum in Support of the Plaintiff's Motion (Docket No. 20) the Defendant Gideon 300 Ministries, Inc.'s Response (Docket No. 23), and the Plaintiff's Reply Brief (Docket No. 26), the Defendant's Motion for Summary Judgment (Docket No. 18), and the Plaintiff's response thereto (Docket No. 24), IT IS HEREBY ORDERED that the Defendant's Motion for Summary Judgment is **DENIED** and the Plaintiff's Motion for Summary Judgment is **DENIED**.

BY THE COURT:

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HERBERT J. HUTTON, J.